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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,358	11/26/2003	Heiko Glienicke	4106-0132P	6146
2292	7590	06/17/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			CHOI, JACOB Y	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,358

Applicant(s)

GLIENICKE ET AL.

Examiner

Jacob Y. Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/26/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/26/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 11/26/2003 was considered by the examiner.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 6.3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the light scattering components, the symbol area, the circumferential side, the single piece, at least one light-diverting bevel must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 4 and 15 objected to because of the following informalities: negative limitation phrases such as; "not illuminated", "a user is not able to", and "light is not being emitted" should be revised and applicant is advised to use terminology that are positive rather than negative. Appropriate correction is required.

6. Claim 9 is objected to because of the following informalities: a broad range or limitation followed by linking terms (e.g., preferably, maybe, can be, for instance, especially) and a narrow range or limitation within the broad range or limitation is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

7. Claim 15 is objected to because the phrase "and/or" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-9 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa et al. (USPN 5,093,764).

Regarding claim 1, Hasegawa et al. discloses an optical light guide (6) that includes two parts (inner portion & outer portion; column 3, lines 40-55), which are partially separated by an annular slot (7; *"whereby the panel surface light guide 6 is divided into an outer knob illuminating portion 6c as a portion internally of the shield plate 7 and a panel surface illuminating portion 6d externally thereof ..."*), such that parts of the panel can engage or project into the slot, a light rotor (4) that extends towards the optical light guide (Figures 2 & 4) to a height necessary for light transport, and a light source (24) located below the light rotor (4).

Regarding claim 2, Hasegawa et al. discloses arranged on the scale (Figure 1, 23a) around the rotary knob (1, 2) of the control element are symbols (2a, 3a), which are back lighted in the night design and are easily recognizable in the daylight design by establishing appropriate contrast with their surroundings.

Regarding claim 3, Hasegawa et al. discloses the symbols are produced by a laser, injection-molding, or film technique (column 3, lines 30-40). The method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Regarding claim 4, Hasegawa et al. discloses the corona is illuminated in the night design as a luminous ring around the rotary knob and is not illuminated in the daylight design and thus very difficult or impossible to detect (columns 1-2, lines 15-15).

Regarding claim 5, Hasegawa et al. discloses the brightness of the scale is corona is regulated by light scattering wall thickness in the symbol area (23; film).

Regarding claim 6, Hasegawa et al. discloses the brightness of the scale and corona is regulated by an appropriate wall thickness in the symbol area (23; film).

Regarding claim 7, Hasegawa et al. discloses the brightness of the scale and corona is regulated by at least one light-diverting bevel on an underside of the optical light guide on a circumferential side.

Regarding claim 8, Hasegawa et al. discloses the optical light guide is fixed relative to the control element.

Regarding claim 9, Hasegawa et al. discloses the optical light guide can be adjusted in functional combination with the light rotor.

Regarding claim 11, Hasegawa et al. discloses a rotary knob (2, 3), a corona substantially circumscribing the rotary knob (2, 3), the corona being adapted to emit light therefrom, a scale (23) substantially circumscribing the corona and the rotary knob (2, 3), the scale (23) being adapted to emit light therefrom, an optical light guide (6) having an annular slot (inner portion & outer portion; column 3, lines 40-55) provided therein, the annular slot being formed to receive a projection extending (7) from the scale, the optical light guide (6) directing light towards the scale and the corona, and a light rotor (4) that directs (6b) light from a light source towards the optical light guide (6).

Note: it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Also, claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding claim 12, Hasegawa et al. discloses the scale completely circumscribes the corona and the corona completely circumscribes the rotary knob.

Regarding claim 13, Hasegawa et al. discloses the light rotor directs light towards the optical light guide from an outer perimeter of the light rotor.

Regarding claim 14, Hasegawa et al. discloses the scale includes at least one symbol formed thereon.

Regarding claim 15, Hasegawa et al. discloses a surface of the corona is formed to resemble a surface of the rotary knob and/or the scale such that a user is not able to detect the corona when light is not being emitted by the corona.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa et al. (USPN 5,093,764).

Regarding claim 10, Hasegawa et al. discloses the optical light guide and the light rotor are formed as two-pieces.

Hasegawa et al. discloses the claimed invention except for the optical light guide and the light rotor is formed as a single piece.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make both of the light guide (optical light guide & light rotor) into a single piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Glienicke (USPN 6,224,221) – illuminated rotatable knob

Herzog et al. (USPN 6,422,710) – illuminated display graduated scale device

Kato et al. (USPN 6,318,872) – vehicle light meter having two colored layers with ring member dial

Glienicke (USPN 6,356,394) – mushroom shaped light guide

Bauer et al. (USPN 6,392,175) – control element for control functions

Obata (USPN 4,807,091) – illuminating device for an electric part

Bauer et al. (USPN 4,800,466) – illumination device for a front panel

Bauer et al. (USPN 4,646,206) – control unit

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC

A handwritten signature in black ink, appearing to read 'JAW', is positioned above the printed name of the examiner.

**JOHN ANTHONY WARD
PRIMARY EXAMINER**